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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,790	10/01/2003	Christopher S. Piddington	99-10C1	2402

7590 05/19/2006

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EXAMINER

DANG, IAN D

ART UNIT PAPER NUMBER

1647

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/676,790	PIDDINGTON ET AL.	
	Examiner	Art Unit	
	Ian Dang	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Formal Matters

This office action is in response to the amendment and response filed on March 6, 2006.

Claims 1-27 are pending and under consideration by the examiner.

Response to Amendment

The rejection of pending claims 1-27 under 35 USC § 101 and § 112 still stand.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-27 remain rejected under 35 USC § 101 because the claimed invention is not supported by either a credible, specific, and substantial asserted utility or well-established utility. The basis for this rejection is set forth on pages of the previous Office action mailed on November 15, 2005.

Applicants' arguments mailed on March 6, 2006, (page 3) have been fully considered but are not deemed to be persuasive for the following reasons:

Applicants argue that the claimed invention has utility in accordance with the Utility Examination Guidelines. Specifically, Applicant argues that zacrp5 is a member of the conserved adipocyte complement related family of proteins. Applicants argue that each member of the family has a specific, substantial, and credible utility. Applicants recite that the examiner has not provided sound scientific reasoning to refute the assertions of utility of the

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claimed invention. This has been fully considered but is not found to be persuasive. The previous Office action addressed zacrp5's membership in a protein family including zsig37 (see page 3 of the previous Office action). In this case, the membership of zacrp5 in a protein family does not provide evidence that the protein has a credible, specific, and substantial utility, because the protein family to which it belongs is made up of members, which, through structurally related, are functionally diverse. Several examples were provided with the previous Office action as evidence that structural similarity does not correlate with their functional similarities. In addition, Applicants have not provided evidence in the specification that the polynucleotide disclosed can be used as probes or primers or involved in any pathological disorders (see previous Office action page 7). The previous Office action set forth a prima facie rejection for lack of patentable utility under 35 USC § 101. Applicants have provided no new evidence supporting utility of the claimed invention. Therefore the rejection is maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-27 remain rejected under 35 USC 112, first paragraph. Since the claimed invention is not supported by either a credible, specific, and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. The reasoning for this rejection was set forth at pages 8-10 of the previous Office action (mailed on November 15, 2005).

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Applicant argues (page 4, March 6, 2006) that this rejection should be withdrawn for the reasons set forth in their traversal of the utility rejection. This has been fully considered but is not found to be persuasive for the reasons given above in the maintained rejection under 35 USC § 101.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ian Dang whose telephone number is (571) 272-5014. The examiner can normally be reached on Monday-Friday from 9am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ian Dang
Patent Examiner
Art Unit 1647
May 8, 2006

Marianne P. Allen
MARIANNE P. ALLEN
PRIMARY EXAMINER
5/16/06
AU1647